

Application Serial Number 09/773,417
Response to Office Action
Dated April 5, 2005

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REMARKS / DISCUSSION OF ISSUES

Claims 1-9 are pending in the application upon entry of the present amendment. Claims 1,4,5 and 7 are the independent claims.

Rejections Under 35 U.S.C. § 103

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable in over Karam, et al. (U.S. Patent 5,148,448) in view of Chow, et al. (U.S. Patent 6,614,854) For at least the reasons set forth below, it is respectfully submitted that this rejection is improper and should be withdrawn.

A proper rejection under 35 U.S.C. § 103(a) requires that all of the claimed elements be found in the applied art. If a single claimed element is not found in the applied art, a prima facie case of obviousness cannot be properly established.

Furthermore, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is reason, suggestion or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. However, hindsight is never an appropriate motivation for combining references.

Claim 1 includes the "...first transceiver is varied in response to a **control signal stream generated in said second transceiver** to counter the effects of channel distortion on a constellation of a recovered symbol stream..."

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Claims 4 and 5 include a similar feature.

Claim 7 features "...means responsive to an external control signal indicating the presence of constellation errors due to channel distortion in signals propagated by the propagating/receiving means, said control signal being applied to said means for adjusting the magnitude of the data signals, to predistort the data signals to be applied to the vector modulator."

It is respectfully submitted that at least the noted features of claims 1, 4, 5 and 7 are not disclosed in the applied reference to Chow, et al. In particular, the reference to Chow, et al. discloses that node 402 may return information regarding the characteristics of the signal from node 401, such as may be sample or measured by device 430. This information may be sent by a communications channel using the antennae 454 and 453. The node 402 may transmit specialized overhead data through the transmitter 425 and may use a predistorter circuit (not shown). The overhead data may include predistortion requirements. A demultiplexer or controller circuit 418 provides the predistortion information to the predistorter 410. (Kindly review column 12, line 55 through column 13, line 34 of Chow, et al. for support for the above assertion.)

Accordingly, while the reference to Chow, et al. discloses providing information regarding characteristics of the signal from node 402 to node 401, it specifically lacks at least the disclosure of a first transceiver is varied in response to a control signal stream generated in said second transceiver as featured in claim 1; and the

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disclosure of means responsive to an external control signal indicating the presence of constellation errors due to channel distortion.

Stated differently, information may be passed from the node 402 to the node 401 in Chow, et al. and this information may include predistortion requirements, but Chow, et al. does not disclose the control signal or external control signal as recited in claims 1,4 and 5, and claim 7, respectively.

Therefore, because the reference to Chow, et al. lacks the disclosure of at least one of the features of each of claims 1,4,5 and 7, it cannot serve to establish a proper prima facie case of obviousness. Thus, it is respectfully submitted that independent claims 1,4,5 and 7 and the claims that depend therefrom are patentable over the applied art.

In addition to the traversal of the rejection of claims 1, 4, 5 and 7 set forth above, it is respectfully submitted that the combination of references of the present rejection is improper as lacking the requisite motivation for such a combination. The Office Action states "Karam does not disclose receiving a signal from [the] receiver to correct for predistortion." Moreover, the Office Action states "It would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate the teachings of Chow in to the transmitter of Karam." The Office Action then recites certain features of Chow, et al. (Kindly refer to pages 4 and 5 of the Office Action.)

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For reasons set forth above, it is reiterated that like to *Karam, et al.*, *Chow, et al.* lacks the disclosure of control signals as recited in claims 1,4,5 and 7. This notwithstanding, a mere statement and a few features of a reference does not provide the requisite reason, suggestion or motivation to combine references. Rather, such reason, suggestion motivation must be provided from the applied references themselves or knowledge generally available to one of ordinary skill in the art. Such has not been provided. Therefore, the requisite reason, suggestion or motivation to combine references not having been provided, it is respectfully submitted that the present rejection is improper at least for this reason.

Accordingly, for at least the reasons set forth above, it is respectfully submitted that the reference to *Chow, et al.* cannot serve to establish a prima facie case of anticipation of independent claims 1,4,5 and 7. As such, it is respectfully submitted that claims 1,4,5 and 7 are patentable over the applied art. Moreover, claims 2,3,6, 8 and 9, which depend from the independent claims are also patentable over the applied art at least because of their dependence on claims 1,4,5 and 7.


Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be

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resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
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